

REMARKS

These Remarks are presented in response to the Office Action. Claims 1, 4, 7-11, 14, 16, 18, and 22 are amended herein. Claims 1-22 remain pending in this application.

Reconsideration of this application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, the remarks of the Applicant are presented in the order in which the corresponding issues were raised in the Office Action.

Applicants note that the amendments and remarks presented herein have been made merely to clarify the claimed embodiments in light of the objections as to formal matters by the Examiner. Such amendments and remarks, or a lack of remarks, should not be construed as an acquiescence, on the part of the Applicant, as to the validity of the objections as to formal matters noted by the Examiner, nor as to the characterization of the formal matters advanced by the Examiner. Accordingly, Applicant reserves the right to challenge the validity of the alleged informalities at any appropriate time.

1. Formal Matters

The Examiner has stated that the application is in condition for allowance except for the formal matters discussed below.

A. Declaration

The Examiner objects to the form of the Declaration because it provides the post office addresses of the inventors but does not indicate the residence addresses, and because each inventor's signature is contained on a page separate from the text of the Declaration. In view of the newly executed Declarations submitted herewith, Applicant submits that the objection of the Examiner has been overcome and should be withdrawn.

B. Priority

The Examiner makes two objections to the claims of priority recited in this application. First, the Examiner objects to the basis of priority because this application is a Continuation-In-

Part Application of US utility patent applications 10/285,082 (the "'082 Application") and 10/285,081 (the "'081 Application"), but also claims priority to provisional applications 60/423,968 (the "'968 Application"), 60/422,598, and 60/422,959 (the "'959 Application"), two of which were filed 6 days after the parent applications. The Examiner asserts that since the '968 and '959 Applications were filed after the '081 and '082 Applications, "there is an ambiguity with respect to exactly what is the basis for priority here with respect to those two provisional applications." Applicant respectfully disagrees however, and submits that the objection should be withdrawn.

In general, Applicant submits that priority claims to multiple cases, each of which may reflect a different filing date, is a common occurrence and no ambiguity is implicated *per se* by such priority claims. Regarding the present application, the Examiner has not identified what is believed to be ambiguous about a situation where, as here, an application claims priority to a pair of earlier filed cases (the '081 and '082 Applications) cases for whatever materials are disclosed there, while simultaneously taking advantage of the filing date of the disclosure of other cases (the '968 and '959 Applications) filed after the aforementioned earlier filed cases, but before the present case.

Moreover, the Examiner has cited no authority for the assertion, made by the Examiner, that a "correction" is required to a priority claim such as appears in this case. If such authority exists, Applicant respectfully invites the Examiner to identify the same for consideration by the Applicant.

In view of the foregoing, Applicant submits that the objection to the priority claim recited in this case should be withdrawn.

As indicated above, the Examiner has made a further objection to the claim of priority recited in this case. Particularly, the Examiner has objected to the fact that the '968 Application has a different title than the instant application, and has stated that "appropriate explanation/correction is required." As discussed below however, Applicant respectfully disagrees however, and submit that the objection should be withdrawn.

The Examiner has cited no authority to support the proposition that parent and child cases must have identical titles, or to support the proposition that a justification for any differences in the titles must be provided by Applicant. Accordingly, Applicant respectfully submits that this objection should be withdrawn.

C. Current Status of Cross-Referenced Utility Applications

The Examiner objects to the Cross-Reference of related applications in the specification in that it does not provide the current status of U.S. Serial Numbers 10/285,082 and 10/285,081.

In response, Applicants advise that, as of the date of this response, both the '081 and 082 Application are pending. Furthermore, both the '081 and 082 Applications were pending at the time the current application was filed. Applicants have amended the specification to reflect that the '081 and 082 Applications were pending at the time of filing the instant application. Therefore, in light of the foregoing, Applicants submit that the objection has been overcome and should be withdrawn.

D. Abstract of the Disclosure

The Examiner notes that the file name printed below the Abstract of the Disclosure should be deleted. In light of the amendment to the Abstract of the Disclosure herein, Applicant submits that the objection should be withdrawn.

E. Use of Trademarks in Specification

The Examiner notes the use of three trademarks in the present application and reminds Applicants that trademarks should be capitalized wherever they appear in the Application and that the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

In light of the amendments to the specification herein, Applicant submits that the objection should be withdrawn.

F. Missing Period

The Examiner notes paragraph [002] of the specification is missing a period. In light of the amendments to the specification herein, Applicant submits that the objection should be withdrawn.

G. Claim Formalities

The Examiner objects to claims 1-22 under 37 C.F.R. § 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Although the Examiner concedes that he “understands the intentions of the applicant,” and goes on to allow claims 1-22 over the prior art, the Examiner asserts that he “feels confusion *could* be drawn from the limitations” cited to in the Office Action (emphasis added).

Applicants have addressed each of the Examiner’s specific objections below.

1. Alleged Lack of Antecedent Basis – claims 1 and 11

The Examiner objects to claim 1, line 5, and claim 11, line 5 for claiming “said first sequence” where the antecedent basis is “first sequence of bits.” In light of the amendments herein to claims 1 and 11, Applicant submits that the objection has been overcome and should be withdrawn.

2. Alleged Indefiniteness – claim 1

The Examiner objects to claim 1, lines 11-12 which read “said jitter tolerance of said optoelectronic device is determined by reference to said comparison.” The Examiner asserts that “the claim does not particularly point out how exactly the comparison is being used here to determine the jitter tolerance.” The Examiner also states, with regard to this and the other objections made in the Office Action at 1.g), that “While the Examiner understands the intentions of the applicant he feels confusion could be drawn from the limitations cited above.”

Since the Examiner has simply objected to the aforementioned wording of claim 1, rather than making a statutory rejection of that claim, Applicant understands the Examiner to concede

that the claim language at issue satisfies the statutory requirements of 35 U.S.C. § 112, second paragraph. See, e.g., MPEP § 2173.02. In this regard, Applicant notes that “Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used *but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement*” (emphasis added). Id. Further, because the Examiner has determined that a rejection under 35 U.S.C. § 112, second paragraph is not appropriate, “but is of the opinion that the clarity and precision of the language can be improved . . . the examiner may make such a suggestion to the applicant. *If applicant does not accept the examiner’s suggestion, the examiner should not pursue the issue*” (emphasis added). Id.

The foregoing makes clear that while the Examiner has stated that “appropriate correction [to the objected to claims] is required,” Applicant is not, in fact, compelled to amend the claims to which the Examiner has objected. Moreover, Applicant submits that the language of the claims would be clear to one of skill in the art in any event and, accordingly, no amendment is required.

Finally, it was noted earlier that the Examiner has asserted that “confusion *could* be drawn from the limitations cited above” (emphasis added) and, accordingly, “Appropriate correction is required.” While the Applicant has satisfied the statutory requirements, Applicant can do nothing more than guess at what sort of claim amendment(s) would be adequate to meet this new standard articulated by the Examiner. This much, Applicant respectfully declines to do.

In view of the foregoing discussion, Applicant submits that the aforementioned objection to claim 1 should be withdrawn. Applicant also notes that the foregoing discussion is germane as well to the objections to the following claims: claim 7, last line; claim 11, lines 12-13; and, claim 18, last line.

3. Alleged Ambiguity in Preamble – claims 7 and 18

The Examiner objects to the preamble of claim 7 which reads “In a system for measuring...said system comprising...a method for...comprising the steps of.” The Examiner asserts that this structure “creates some ambiguity in the preamble with respect to whether this is a system claim or a method claim.” The Examiner also objects to claim 18 on the same grounds.

In response, Applicants disagree that this preamble structure creates ambiguity as these two claims are clearly method claims. Any assertion that this preamble structure is ambiguous is dispelled by taking note that the final transitional phrase in each preamble is “a method for computing the ... comprising the steps of” (emphasis added). The location of this method transitional phrase at the end of the preamble clearly indicates that any preceding transitional phrases were directed towards elements of the preamble and not to steps in the body of the claim.

Furthermore, the fact that each step listed in these claims following the preamble begins with a gerund (i.e. a noun ending in -ing such as generating, delaying, transmitting, comparing, and using) refutes any assertion that the preamble structure creates ambiguity as to the type of claim. Since each step listed is clearly a step in a method claim and not an element in a system claim, Applicant submits that no amendment is necessary and the objection should be withdrawn.

4. Alleged Lack of Antecedent Basis – claims 7-9

The Examiner objects to claim 7, line 8, and claims 8 and 9 for claiming “said bits” where the antecedent basis is “first sequence of bits.” In light of the amendments herein to claims 7-9, Applicant submits that the objection has been overcome and should be withdrawn.

5. Alleged Indefiniteness – claims 7 and 18

The Examiner object to claim 7, last line, which reads, “using said bit error rate to determine said jitter tolerance.” The Examiner asserts that “the claim does not particularly point out how exactly the bit error rate is being used to determine the jitter tolerance.” The Examiner further objects to claim 11, lines 12-13 which reads, “...said signal attenuation tolerance of said

optoelectronic device is determined by reference to said comparison.” The Examiner asserts that this language “does not particularly point out how exactly the comparison is being used to determine the signal attenuation tolerance.” Likewise, the examiner objects to claim 18, last line, which reads, “using said bit error rate to determine said attenuation tolerance.”

Applicant respectfully directs the attention to the discussion at 1.G.2. above, and submits that for at least the reasons outlined in that discussion, the objection to claims 7 and 18 should be withdrawn.

6. Alleged Lack of Antecedent Basis – claims 13-15

The Examiner objects to claim 13, line 8, claim 14, line 3, claim 15, line 1, and claim 16, line 3, which each recite “said delay” and lack antecedent basis for the “delay.” In light of the amendment to claim 12 herein, Applicant submits that the objection has been overcome and should be withdrawn.

7. Alleged Lack of Antecedent Basis – claims 14 and 16

The Examiner objects to claim 14, line 4, and claim 16, Line 4 which read “said bit error rate” for a lack of antecedent basis. In light of the amendments to claims 14 and 16 herein, Applicant submits that the objection has been overcome and should be withdrawn.

8. Alleged Lack of Antecedent Basis – claim 16 and 22

The Examiner objects to claim 16, lines 5-6, and claim 22, line 5, which read “each of said plurality of data points” and asserts that these claims should read “each data point of said plurality of data points.” In light of the amendments to claims 16 and 22 herein, Applicant submits that the objection has been overcome and should be withdrawn.

9. Alleged Lack of Antecedent Basis – claim 18

The Examiner objects to claim 18, line 8, for claiming “said bits” where the antecedent basis is “first sequence of bits.” In light of the amendment to claim 18 herein, Applicant submits that the objection has been overcome and should be withdrawn.

2. Art Made of Record but Not Cited

Applicant acknowledges the references identified by the Examiner. This acknowledgment should not be construed as an acquiescence, on the part of the Applicants, as to the purported teachings or general interest status of the references, nor as to the characterization of the references advanced by the Examiner. Accordingly, Applicants reserve the right to challenge the purported teaching and general interest status of the references at any appropriate time.

3. Allowable Subject Matter - Claims 1-22

Applicants acknowledge with thanks the indication of the Examiner that claims 1-22 are allowable over the prior art. Applicants also wish to thank the Examiner for the careful review and allowance of these claims.

Applicants submit the following comments concerning the Examiner’s statements of reasons for the indication of allowable subject matter in the Office Action. In general, Applicants agree with the Examiner that the inventions to which claims 1-22 are directed are patentable over the prior art, but respectfully disagree with the Examiner’s statement of reasons for allowance as set forth in the Office Action.

Particularly, Applicants submit that it is improper to characterize a single limitation, or subset of limitations, as constituting the basis for allowance of a claim. Rather, patentability of a claim is properly determined with reference to the claim as a whole. Accordingly, Applicants do not concede that the reasons for allowable subject matter given by the Examiner with respect to claims 1-22 are the only reasons that make, or would make, the claims allowable and Applicants

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do not make any admission or concession concerning the Examiner's statement in the Office Action.

CONCLUSION

In view of the remarks submitted herein, Applicants respectfully submit that each of the pending claims 1-22 is now in condition for immediate allowance. Therefore, reconsideration of the objections is requested and allowance of these claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 23RD day of May, 2005.

Respectfully submitted,



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